

Applicant : Shuping Tong et al.
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Attorney's Docket No.: 00786-287004 / MGH-0960.3
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REMARKS

Claims 1 to 9 are pending in the present application. Applicants thank Examiner Lucas for taking time on May 27, 2003, to discuss with the undersigned's associate why one prior rejection was maintained in the Final Rejection. Applicants appreciate the Examiners' guidance as to what would be required to overcome the rejections of record.

As suggested by the Examiner, and as requested in the Office Action, applicants have amended the specification to include generic terminology following the trademarked term "AMPLIFY." Further, in the interest of moving the present application toward allowance, applicants have amended the specification to insert the text of the pending claims into the Summary. Finally, claim 9 has been amended for reasons of formality. The amendments add no new matter to the present application.

Withdrawn Rejections

Applicants acknowledge the Examiner's withdrawal of the rejections of claims 1, 5, 6, and 9 under 35 U.S.C. §112, second paragraph. Applicants also acknowledge the Examiner's withdrawal of the rejection of claims 1 to 9 under 35 U.S.C. §112, first paragraph, and the withdrawal of the rejections of claims 1, 5, 6, and 9 under 35 U.S.C. §103.

Objections

The Office Action objected to the specification because it allegedly lacks a generic description for the term "AMPLIFYTM solution." Applicants have amended the specification to indicate that AMPLIFYTM solution is a fluorographic reagent. Thus, applicants respectfully request that this objection be withdrawn.

The Office Action objected to claim 9 because the word "the" was missing between the words "wherein" and "polypeptide." Applicants have amended the claim to insert the word "the." Accordingly, applicants request that this objection be withdrawn.

Maintained Rejection

The rejection of claims 1 to 9 for an alleged lack of written description was maintained. During the discussion on May 27, 2003, the Examiner indicated that the reasoning set forth in the

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Office Action in support of the present rejection is somewhat inaccurate. Based on the discussion, applicants understand the Examiner's position to be that the claims lack proper antecedent basis for the claimed subject matter, and that the present rejection can be overcome by inserting the text of the claims into the specification.

Applicants respectfully disagree that the claims lack proper antecedent basis for the claimed subject matter. It is well settled that the "written description" of an invention encompasses all of the information presented in the application as originally filed. This consists of the entire specification, including, without limitation, the title, abstract, field of invention, background, summary, brief description of drawings, detailed description of the invention and mode of operation, claims, abstract, and drawings. The Examiner is referred specifically in this regard to MPEP §2163(I). MPEP §2163(I) says, in relevant part:

It is now well accepted that a satisfactory description may be in the claims or any other portion of the originally filed specification. *[emphasis provided]*

Since the "specification" by definition includes the claims (see MPEP §608.1), and the requirement for "written description" does not require description in two places, there is no requirement that features recited in the claims find antecedent basis elsewhere in the specification. Furthermore, applicants submit that the present claims are amply supported by disclosure throughout the specification, e.g., at page 5, lines 16 to 30, page 6, lines 7 to 14, page 7, lines 11 to 12, page 22, lines 19 to 23, page 28, lines 20 to 23, page 33, lines 3 to 6 and 22 to 23, and at page 38, lines 12 to 13. Thus, no amendment of the specification should be required.

However, in the interest of moving the present application toward allowance, applicants have amended the specification as requested by the Examiner. Accordingly, applicants request that the present rejection be reconsidered and withdrawn.

CONCLUSION

While the Examiner made no promises, applicants understand that upon amending the application as discussed above, the claims would be in condition for allowance. Such action is respectfully requested. Should the present submission be non-persuasive in any way, the Examiner is kindly asked to telephone the undersigned.